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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,581	03/16/2001	Leo J. Campbell	08049.0005	5903

22852 7590 07/09/2004

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EXAMINER

BRUCKART, BENJAMIN R

ART UNIT PAPER NUMBER

2155

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,581

Applicant(s)

CAMPBELL ET AL.

Examiner

Benjamin R Bruckart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-78 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

Claims 1-78 are pending in this Office Action.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-4, 33-36, 65 and 72, are drawn to a method, system, computer usable medium and means for establishing an electronic account over a network, classified in class 709, subclass 223.

II. Claims 5-8, 37-40, 66, and 73 are drawn to a method, system, computer usable medium and means for establishing electronic mail services over a network using an electronic account that generates an electronic address for a user, classified in class 709, subclass 207.

III. Claims 9-12, 41-44, 67 and 74, are drawn to a method, system, computer usable medium and means for processing electronic mail services over a network using an electronic account that receives requests from a service and a user, classified in class 709, subclass 206.

IV. Claims 13-17, 45-49, 68 and 75, are drawn to a method, system, computer usable medium and means for delivering mail, classified in class 709, subclass 206.

V. Claims 18-22, 50-54, 69 and 76, are drawn to a method, system, computer usable medium and means for delivering a message to a user with an electronic account with a lookup of a physical address, classified in class 709, subclass 238.

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VI. Claims 23-27, 55-59, 70 and 77, are drawn to a method, system, computer usable medium and means for delivering a message to a user with an electronic account with a lookup of a electronic address, classified in class 709, subclass 238.

VII. Claims 28-32, 60-64, 71 and 78, are drawn to a method, system, computer usable medium and means for delivering a message to a user with an electronic account with a temporary address and time sensitive delivery, classified in class 709, subclass 207.

The inventions are distinct, each from the other because of the following reason:

Invention Groups I - VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are show to be separately usable. In the instant case, invention in Group I has separate utility such establishing electronic mail services over a network using an electronic account that generates an electronic address for a user. See MPEP § 806.05(c). Invention in Group II has separate utility and is for establishing electronic mail services over a network using an electronic account that generates an electronic address for a user. Group III has separate utility that processes electronic mail services over a network using an electronic account that receives requests from a service and a user. Group IV has separate utility drawn to delivering mail. Group V has separate utility delivering a message to a user with an electronic account with auto completion of a physical address. Group VI has separate utility for delivering a message to a user with an electronic account with an auto completion of a electronic address. Group VII is an invention drawn

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to delivering a message to a user with an electronic account with a temporary address and time sensitive delivery.

Inventions in Group I-VII are unrelated and are found burdensome to the examiner forcing different searches. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are (1) establishing electronic accounts and (2) establishing email services (3) processing email services (4) delivering mail (5) routing messages based on physical address or electronic address and account and (6) time sensitive delivery a message to a temporary address.

Because these inventions are burdensome as different inventions in the art requiring separate search as explained above with their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.

That prima facie showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for

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restriction or election practice relating to claims to genus-species, see MPEP §806.04(a)

- § 806.04(i) and § 808.01(a).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, and so on for Groups I – VII, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin R Bruckart whose telephone number is (703) 305-0324. The examiner can normally be reached on 8:00-5:30 PM with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (703) 308-6662. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0324.

Benjamin R Bruckart
Examiner
Art Unit 2155

brb
July 1, 2004

BB



HOSAIN ALAM
SUPERVISORY PATENT EXAMINER